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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/664,444	09/18/2000	John C Bell	2370-63	4773

7590 03/20/2002

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Legal Department  
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EXAMINER

ZEMAN, ROBERT

ART UNIT

PAPER NUMBER

1645

DATE MAILED: 03/20/2002

14

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/664,444

Applicant(s)

BELL ET AL.

Examiner

Robert A Zeman

Art Unit

1645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 September 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-63 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) 1-63 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Election/Restrictions*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-4, 18-22 and 24-37, drawn to a method of reducing the viability of carcinoma cells by administering a virus, classified in class 424, subclass 93.1.
- II. Claims 1, 5-13, 18-37, drawn to a method of reducing the viability of hematopoietic tumor cells by administering a virus, classified in class 424, subclass 93.1.
- III. Claims 1, 18-22 and 24-37, drawn to a method of reducing the viability of glioblastoma cells by administering a virus, classified in class 424, subclass 93.1.
- IV. Claims 1, 18-22 and 24-37, drawn to a method of reducing the viability of melanoma cells by administering a virus, classified in class 424, subclass 93.1.
- V. Claims 1, 14-16, 18-22 and 24-37, drawn to a method of reducing the viability of sarcoma cells by administering a virus, classified in class 424, subclass 93.1.
- VI. Claims 1, 17-22 and 24-37, drawn to a method of reducing the viability of neuroendocrine tumor cells by administering a virus, classified in class 424, subclass 93.1.
- VII. Claims 38-51, drawn to a method of identifying a tumor susceptible to treatment with a virus, classified in class 424, subclass 9.2.
- VIII. Claims 52-55, drawn to methods of purifying virus, classified in class 435, subclass 248.

- IX. Claims 56-58, drawn to modified viruses, classified in class 435, subclass 235.1.
- X. Claim 59, drawn to a nucleic acid encoding VSV protein N, classified in class 536, subclass 23.1.
- XI. Claim 60, drawn to a nucleic acid encoding VSV protein P, classified in class 536, subclass 23.1.
- XII. Claim 61, drawn to a nucleic acid encoding VSV protein M, classified in class 536, subclass 23.1.
- XIII. Claim 62, drawn to a nucleic acid encoding VSV protein G, classified in class 536, subclass 23.1.
- XIV. Claim 63, drawn to a nucleic acid encoding VSV protein L, classified in class 536, subclass 23.1.

The inventions are distinct, each from the other because of the following reasons:

Inventions I-VIII are separate and distinct from each other as they are drawn to differing methods having different steps and leading to differing results.

Inventions IX-XIV are separate and distinct from each other as they comprise differing biochemical and physical entities having differing properties and uses. Invention IX is drawn to modified viruses, whereas Inventions X-XIII are drawn to nucleic acids

Inventions X-XIV are separate and distinct from Inventions I-VI as the substances of Inventions X-XIV cannot be used in the methods of Inventions I-VI.

Invention IX and Inventions I-VII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the

Application/Control Number: 09/664,444  
Art Unit: 1645

Page 4

process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the viruses of Invention IX can be used in other methods such as antibody production.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert A Zeman whose telephone number is (703) 308-7991. The examiner can normally be reached on M-Th 7:30 am - 5:00 pm and Alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donna Wortman can be reached on (703) 308-1032. The fax phone numbers for the

Application/Control Number: 09/664,444

Page 5

Art Unit: 1645

organization where this application or proceeding is assigned are (703) 308-4242 for regular communications and (703) 308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

  
DONNA WORTMAN  
PATENT EXAMINER

Robert A. Zeman  
March 11, 2002